REMARKS

Re-examination and reconsideration of the subject matter identified in caption, pursuant to and consistent with 37 C.F.R. §1.112, and in light of the remarks which follow, are respectfully requested.

Claims 1-50 were rejected under 35 U.S.C. §112, first paragraph, as allegedly non-enabling for the reasons given in paragraph (1) of the Office Action. Reconsideration and withdrawal of this rejection are requested for at least the following reasons.

Applicants note that the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright,* 999 F.d 1557, 27 U.S.P.Q.3d 1510 (Fed. Cir. 1993). In fact, a specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement of 35 U.S.C. §112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. See M.P.E.P. §2164.04 and *In re Marzocchi*, 439 F.2d 220, 169 U.S.P.Q. 367 (CCPA 1971).

The first paragraph of 35 U.S.C. §112 merely requires that the specification enable one skilled in the at to make and use the invention without undue experimentation. See In re Borkowski, 164 USPQ 642 (CCPA 1970). A detailed description or working example of every possible embodiment falling within a particular claim simply is not (nor has it ever been) a requirement of the first paragraph of 35 U.S.C. §112. In this regard, it is not the function of claims to

specifically exclude possible inoperative embodiments. See, *e.g.*, In re Dinh-Nguyen, 181 USPQ 46 (CCPA 1974); Ex parte Janin, 209 USPQ 761 (POBA 1979); and Ex parte Jackson, 217 USPQ 804 (POBA 1982). The breadth of the claims is irrelevant so long as they set forth an invention which is described in the specification such that one skilled in the art can make and use the invention. The Examiner should determine what each claim recites and what the subject matter is when the claim is considered as a whole, not when its parts are analyzed individually.

With the above principles in mind, Applicants respectfully submit that the scope of enablement in the present application is commensurate in scope with the claims when considered as a whole. Those skilled in the art would be able to practice the claimed invention given the information in the disclosure coupled with the level of knowledge and skill in the art. The scope of enablement only needs to bear a "reasonable correlation" to the scope of the claims. Thus, in order to sustain a non-enablement rejection under 35 U.S.C. §112, first paragraph, the burden is on the Examiner to provide cogent reasons why those of ordinary skill in the relevant art would not be able to practice the invention defined by the claims based on a review of the specification coupled with the technical knowledge possessed by the routineer in the art. Applicants respectfully submit that the entire specification and the working examples when coupled with the technical knowledge possessed by those of ordinary skill in this art clearly enables those of ordinary skill to practice the presently claimed invention.

The rejection states on page 2: "It is not clear from the language what level of amine or what type of amine must be avoided; it is by no means clear how the amine

concentration is to be controlled in formulating a high gloss coating, and it cannot be determined what other factors influence the high gloss characteristic."

Respectfully, Applicants disagree and submit that the specification contains ample information regarding the content of amine to be avoided to ensure a high gloss coating. Page 22 discloses cross-linking catalysts which are known to enhance matt coatings, i.e., their content should be controlled to avoid adversely affecting high gloss. Page 22, line 12 indicates clearly that the content of matt-enhancing catalysts should be limited to less than 0.6% by weight. Amines are mentioned in line 28 as catalysts to be avoided or minimized in amounts. The data on pages 27-28 unequivocally discloses that an amine content of over 2% equivalent results in a coating which is not high gloss whereas amine contents of 0.5% equivalent or less result in high gloss coatings

U.S. Patent No. 6,291,624 relates to polyurethane coatings having a matt finish. The disclosure of this patent (column 13) discusses the type and amounts of amines which provide matt coatings. Those of ordinary skill in this art familiar with the disclosure of the '624 patent and the present disclosure including the working examples, would readily be able to ascertain without undue experimentation, the types of amines and their content to be avoided in order to obtain a high gloss content.

For at least the above reasons, the §112, first paragraph, rejection should be withdrawn. Such action is earnestly requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at (703) 838-6683 at his earliest convenience.**

Respectfully submitted,

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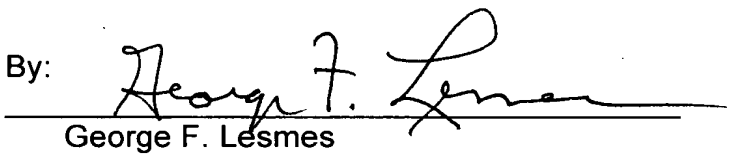
By: 

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